

Remarks:

The above amendments and these remarks are responsive to the Office action dated September 2, 2005. Claims 1-29 are pending in the application. In the Office action, the Examiner rejected claims 1-16 and 26-29 under 35 U.S.C. § 101 and claim 12 under 35 U.S.C. § 112, second paragraph. Additionally, the Examiner rejected claims 1-29 under 35 U.S.C. § 102(a) or 103(a) based on Libman (U.S. Patent No. 6,076,072). In view of the amendments above, and the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejections under 35 U.S.C. § 101

Claims 1-16 and 26-29 are rejected under 35 U.S.C. § 101 because the claimed invention is not in the technological arts. The Examiner cited case law supporting his position that because "all recited steps could be performed manually by a human" the claimed invention is not limited to the technological arts and the claims are thus subject to rejection.

Subsequent to the cases cited by the Examiner, however, the Board of Patent Appeals and Interferences rendered its decision in *Ex parte Lundgren*, Appeal No. 2003-2088 (Bd. Of Patent Appeals and Interferences 2005). In that case, the Board held that there is "no judicially recognized separate technological arts test to determine patent eligible subject matter under § 101" (internal quotations omitted). Instead, the claimed invention must simply meet the requirements of 35 U.S.C. § 101, which provides: "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

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thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

Claims 1-16 are directed to a "process" or a method for providing targeted advertising to a customer, while claims 26-29 are directed to a "manufacture" or a billing statement for providing marketing information to a customer. Claims 1-16 and 26-29 are not directed to laws of nature, physical phenomena, or abstract ideas. Thus, claims 1-16 and 26-29 are directed to patentable subject matter and the rejections under 35 U.S.C. § 101 should be withdrawn.

Rejections under 35 U.S.C. § 112

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, because it contradicts claim 11, which it depends from. Applicants have amended claims 11 and 12 to clarify the subject matter of those claims. Thus, applicants request that the rejection of claim 12 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-3, 16-17 and 19-29 are rejected under 35 U.S.C. § 102(a) as being anticipated by Libman (U.S. Patent No. 6,076,072).

Libman discloses a method and apparatus for automatically preparing financial product and/or financial service-related communications (such as advertisements and solicitations) for dissemination to clients and potential clients. As shown in Fig. 2, the method and apparatus receives client information, financial product information, and ancillary information and generates a client communication.

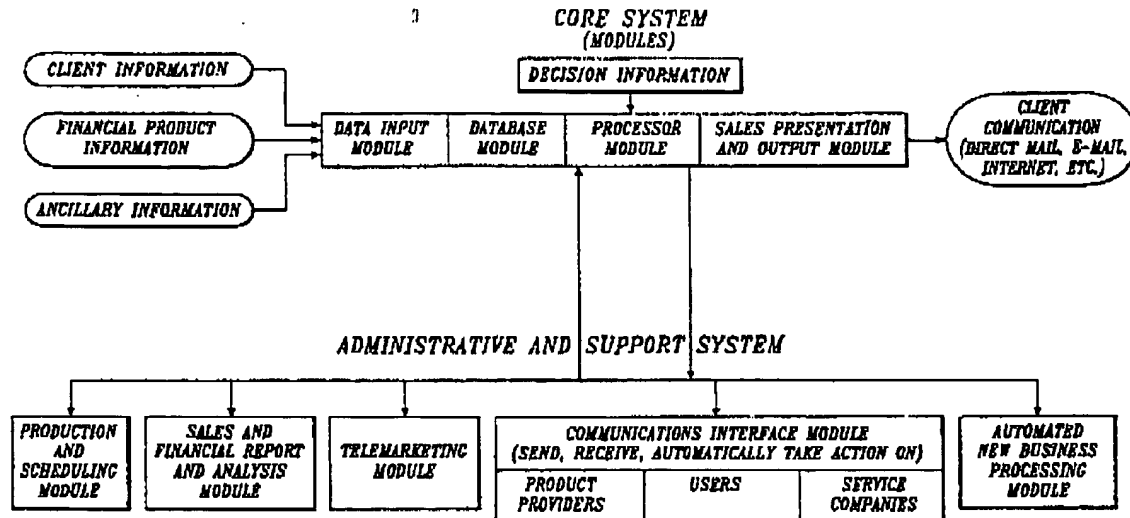


Fig. 2

"Client information" is defined in Libman (col. 5, Ins. 50-61) as:

[I]nformation which pertains to a particular client, or to a particular set or group of clients. Examples of client information would include a client name, address, telephone number, age, marital status, occupation, employer, financial income, etc. Client information also may include information pertaining to the family or other relations to the client, such as information on the spouse, children, parents, etc., or perhaps to a business associate, such as a business partner, fellow board member or officer, and the like. This category of information also may include psychographic and demographic data pertaining the client or clients.

In contrast, "ancillary information" is defined in Libman (col. 11, Ins. 56-67) as:

[V]irtually any type of data or information useful for the system (hardware and software of FIGS. 1 and 2) and/or method in performing the intended functions, but excludes client information, financial product information and decision information. Examples of such ancillary data or information would include statistical information, geo-code data, and the like. Non-client specific information also may be included in this category, such as demographic, psychographic or buying habit data. Incidentally, the term "information" is used broadly herein to include quantitative data as well as other forms of information.

Libman does not, however, disclose or suggest a method that includes retrieving an item of customer information relating to the customer, wherein the customer information includes information regarding past consumption of goods and services by the customer, as recited in amended independent claim 1. Instead, the Libman method receives ancillary information that includes non-client specific buying habit information. There is no disclosure or suggestion of retrieving past consumption of goods and services for the particular client who will receive the targeted advertising. Thus, Libman fails to disclose or suggest applicants' method as recited in amended claim 1.

For at least the foregoing reasons, claim 1 is allowable and the rejection of claim 1 based on Libman should be withdrawn. Claims 2-3 and 16 depend from claim 1, and thus are allowable for at least the same reasons as claim 1.

Similar to claim 1, amended independent claim 17 recites a billing system that includes a computer system configured to retrieve customer information for the selected customer from the database system, wherein the customer information includes information regarding past consumption of good and services by the customer. Claim 17 thus is allowable for at least the same reasons set forth above in connection with claim 1, and the rejection of claim 17 based on Libman should be withdrawn. Claims 19-20 and 22-25 depend from claim 17, and thus are allowable for at least the same reasons as claim 17.

Also similar to claim 1, amended Independent claim 26 recites a billing statement that includes a marketing portion with marketing information based on information related to a characteristic of the customer, wherein the information related to the characteristic of the customer includes information related to past purchasing of goods and services by the customer. Claim 26 thus is allowable for at least the same reasons as set forth above in connection with claim 1, and the rejection of claim 26 based on Libman should be withdrawn. Claims 27 and 29 depend from claim 26, and thus are allowable for at least the same reasons as claim 26.

Rejections under 35 U.S.C. § 103

Claims 14 and 18 are rejected under 35 U.S.C. § 103(a) as being obvious over Libman (U.S. Patent No. 6,076,072) in view of "Official Notice." In particular, the Examiner asserts that "It is old and well known to collect information from customers via survey." Applicants respectfully decline to accept that collecting survey information is "old and well known" in the claimed context, and asks that the Examiner provide support for such assertion.

Claims 14 and 18 depend from claims 1 and 17, respectively. For at least the same reasons as amended claims 1 and 17, claims 14 and 18 are allowable and the rejections of those claims based on Libman and Official Notice should be withdrawn.

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Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner R. Alvarez, Group Art Unit 3622, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on December 1, 2005.



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